

**Notice of Allowability**

Application No.

09/818,692

Applicant(s)

TANAKA ET AL.

Examiner

Art Unit

Shaojia A. Jiang

1617

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to September 29, 2004.
2. ☒ The allowed claim(s) is/are 1-17 and 23 (now renumbered to 1-18).
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☒ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date hereto
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
- ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
- ☒ Examiner's Amendment/Comment
- ☒ Examiner's Statement of Reasons for Allowance
- ☐ Other \_\_\_\_\_

*SAO*  
**SHAOJIA ANNA JIANG**  
**PATENT EXAMINER**  
*2/16/05*

### **DETAILED ACTION**

The appeal brief filed September 29, 2004 is acknowledged.

This Office Action is a response to Applicant's appeal brief filed September 29, 2004. Currently, claims 1-17 and 23 are pending in this application.

#### Priority

As indicated in the previous Office Action March 24, 2004, this application is a continuation in part of 08671943 now abandoned which is a continuation of 07969176 now abandoned. Note that Applicant also claims foreign priority to Japan 2/216403 under 35 U.S.C. 119(a)-(d). The copy of certified copy of the priority has been filed with the instant Application. However, either the foreign priority document or the domestic priority documents upon which priority is claimed fail to provide adequate support under 35 U.S.C. 112 for the instant claims of this application since they do not disclose the essential or critical feature of the invention herein, SiO<sub>2</sub> being non-porous, claimed herein, as Applicant asserts in the brief (see page 12 line 6-9).

Therefore, the effective and actual filing date of the instant claims is deemed to be the filing date of the instant application, March 23, 2001.

#### ***Examiner's Comment***

#### Drawing

Applicant is required to submit the correcting drawing for Figure 2-5 and 11, since these figures are photographs originally, but now unclear due to scanned files.

Applicant's declaration of Hirokazu Tanaka (inventor), submitted September 24, 2004 under 37 CFR 1.132, is acknowledged and will be further discussed below.

### ***Reasons For Allowance***

Claims 1-17 and 23 are examined on the merits herein.

The claimed method of producing a flaky fine power (see claims 1-2, 5-9, and 23), and the claimed compositions (see claims 3-4 and 1-17) are not seen to be taught or fairly suggested by the prior art, as discussed below.

Applicant's remarks/arguments in the appeal brief filed September 29, 2004 and the declaration of Hirokazu Tanaka submitted September 24, 2004 under 37 CFR 1.132 have been fully considered with respect to the rejection of claims 1-17 and 23 under 35 U.S.C. 103(a) as being unpatentable over Seo et al. (6,030,627) in view of Golz-Berner et al. (6,309,627) in the previous Office Action dated March 24, 2004 have been considered and found persuasive to remove this rejection, since, first, Seo et al. do not expressly disclose the average particle size of SiO<sub>2</sub> and SiO<sub>2</sub> being non-porous.

Second, Seo et al. do not teach a coating layer of silica particles having a spherical form but merely teach forming an amorphous glassy inorganic coating layer of metal oxides including silica powder over the surface of inorganic cosmetic pigment, as Applicant asserts in the brief (see page 9-10). The coating layer of the present invention comprises particles which have a spherical form deposited on a base having a flat grain size (Fig. 2 and 3 of this application).

Third, the unexpected results of the claimed invention in the record have been considered and found sufficient to rebut the prima facie case of obviousness, i.e., the

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property of homogeneous light distribution as illustrated in Figs. 6-8 and 10 of this application showing that the glossiness is reduced and reflected light on the uneven surface of the substance is not partial to a certain angle and is distributed homogeneously (see also Applicant's declaration Fig 1-2); the unexpected properties of the product of the present invention are illustrated in the new subject matter in this CIP application in Example 1, page 11, line 4, and Fig. 11, said subject matter proving that the silica particles are spherical and non-porous, and that there is no air void at the surface or in the spherical silica, as Applicant asserts in the brief (see page 11-12).

Therefore, the cited prior art are not deemed to render the instant claimed methods and compositions obvious to one of ordinary skill in the art. Therefore, the said rejection is withdrawn.

Accordingly, the application is deemed in condition for allowance.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner S. A. Jiang whose telephone number is 571.272.0627. The examiner can normally be reached on 9 am -5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571.272.0629. The fax phone

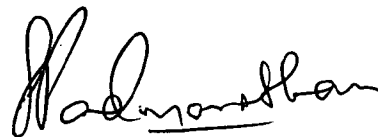
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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Anna Jiang, Ph.D.  
Primary Examiner,  
Art Unit 1617  
February 16, 2005



**SREENI PADMANABHAN**  
SUPERVISORY PATENT EXAMINER